



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,930	09/19/2001	Tsuyoshi Hiramatsu	3273-0146P	3012
2292	7590	05/03/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 05/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Applicati n No. 09/936,930	Applicant(s) HIRAMATSU ET AL.	
	Examiner Victor S Chang	Art Unit 1771	

--The MAILING DATE of this communicati n appears on th cover sheet with the c rrespondence address --

THE REPLY FILED 14 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 April 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached NOTE.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2-4, 8 and 20-23.

Claim(s) withdrawn from consideration: 1, 5-7 and 9-19.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300 1700

Daniel Zinker

NOTE

1. The proposed amendments to claims are not compliant with the revised amendment practice 37 CFR 1.121. In particular, claim 3 should be marked with expression "(currently amended)". Since amendments to the claims are not compliant, they cannot be entered until appropriate correction is submitted.
2. This application contains claims 1, 5-7 and 9-19 drawn to an invention nonelected without traverse in Paper No. 9 (see Office action mailed 1/29/2003). A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.
3. It is noted that the proposed amendments to claims 2 and 3 now recite an additional contemplated method of use step in the article claim preamble, i.e., "removal of a solvent-containing substance by sticking to and peeling off from an article to be cleaned", which appears to be acceptable if it were the only remaining issue. Applicants have, however, also changed the scope of the pressure-sensitive adhesive layer as comprising (A) acrylic pressure-sensitive adhesive and (B) rubber pressure-sensitive adhesive. While such amendments, particularly the addition of a new scope to the pressure-sensitive adhesive layer, appear to overcome the rejection under 35 U.S.C. 112, first paragraph, they clearly also raise new issues that would require further consideration and/or search. Further, the Examiner notes that the proposed new scope of the adhesive layer also appears to be indefinite as to whether components (A) and (B) are a mixture or a Markush group; the latter seems to be proper, but would be

Art Unit: 1771

inconsistent with the clause initialized by the term "comprises". Finally, the Examiner notes that in the proposed amendment to claim 22, the deletion of the monomer mixture also changes the scope of the invention, as the deleted elements are clearly not commensurate with the proposed amendments to claims 2 and 3, and as such requires additional consideration and/or search. If further prosecution, i.e., a CPA or RCE, is contemplated, clarification is requested.

4. Applicants' argument that "Applicants ... refer the Examiner to *Ex Parte Parks*, which cites *Ex Parte Grasselli*, in support of their position ... Based on the present specification and the Examples, there are multiple instances of not including a foaming pressure sensitive adhesive layer is within Applicants' invention. Accordingly, ... Applicants have sufficient written description of their invention" (Remarks, page 16) has been carefully considered and is not persuasive. It should be noted that any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. See MPEP § 2173.05(i).